PTO/SB/17 (10-03)
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U.S. Patent and Trademark Office: U.S. DEPARTMENT OF COMMERCE

FEE TRANSMITTAL for FY 2004

Effective 10/01/2003. Patent fees are subject to annual revision.

☐ Applicant claims small entity status. See 37 CFR 1.27

TOTAL AMOUNT OF PAYMENT ($) 330

Complete if Known	
Application Number	09/605,544
Filing Date	June 29, 2000
First Named Inventor	Colin S. COL
Examiner Name	Anita Choudhary
Art Unit	2153
Attorney Docket No.	003797.86783

METHOD OF PAYMENT *(check all that apply)*

☐ Check ☐ Credit card ☐ Money Order ☐ Other ☐ None

☒ Deposit Account:

Deposit Account Number: 19-0733

Deposit Account Name: Banner & Witcoff, LTD.

The Director is authorized to: *(check all that apply)*
☒ Charge fee(s) indicated below ☒ Credit any overpayments
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FEE CALCULATION

1. BASIC FILING FEE

Large Entity Fee Code	Large Entity Fee ($)	Small Entity Fee Code	Small Entity Fee ($)	Fee Description	Fee Paid
1001	770	2001	385	Utility filing fee	
1002	340	2002	170	Design filing fee	
1003	530	2003	265	Plant filing fee	
1004	770	2004	385	Reissue filing fee	
1005	160	2005	80	Provisional filling fee	

SUBTOTAL (1) ($) 0

2. EXTRA CLAIM FEES FOR UTILITY AND REISSUE

			Extra Claims		Fee from below	=	Fee Paid
Total Claims		- ** =	0	X		=	0
Independent Claims		- ** =	0	X		=	0
Multiple Dependent	0			X	290	=	0

Large Entity Fee Code	Large Entity Fee ($)	Small Entity Fee Code	Small Entity Fee ($)	Fee Description
1202	18	2202	9	Claims in excess of 20
1201	86	2201	43	Independent claims in excess of 3
1203	290	2203	145	Multiple dependent claim, if not paid
1204	86	2204	43	** Reissue independent claims over original patent
1205	18	2205	9	** Reissue claims in excess of 20 and over original patent

SUBTOTAL (2) ($) 0

**or number previously paid, if greater; For Reissues, see above*

FEE CALCULATION (continued)

3. ADDITIONAL FEES

Large Entity Fee Code	Large Entity Fee ($)	Small Entity Fee Code	Small Entity Fee ($)	Fee Description	Fee Paid
1051	130	2051	65	Surcharge - late filing fee or oath	
1052	50	2052	25	Surcharge - late provisional filing fee or cover sheet.	
1053	130	1053	130	Non-English specification	
1812	2,520	1812	2,520	For filing a request for reexamination	
1804	920*	1804	920*	Requesting publication of SIR prior to Examiner action	
1805	1,840*	1805	1,840*	Requesting publication of SIR after Examiner action	
1251	110	2251	55	Extension for reply within first month	
1252	420	2252	210	Extension for reply within second month	
1253	950	2253	475	Extension for reply within third month	
1254	1,480	2254	740	Extension for reply within fourth month	
1255	2,010	2255	1,005	Extension for reply within fifth month	
1401	330	2401	165	Notice of Appeal	
1402	330	2402	165	Filing a brief in support of an appeal	330
1403	290	2403	145	Request for oral hearing	
1451	1,510	1451	1,510	Petition to institute a public use proceeding	
1452	110	2452	55	Petition to revive – unavoidable	
1453	1,330	2453	665	Petition to revive – unintentional	
1501	1,330	2501	665	Utility issue fee (or reissue)	
1502	480	2502	240	Design issue fee	
1503	640	2503	320	Plant issue fee	
1460	130	1460	130	Petitions to the Commissioner	
1807	50	1807	50	Processing fee under 37 CFR 1.17 (q)	
1806	180	1806	180	Submission of Information Disclosure Stmt	
8021	40	8021	40	Recording each patent assignment per property (times number of properties)	
1809	770	2809	385	Filing a submission after final rejection (37 CFR § 1.129(a))	
1810	770	2810	385	For each additional invention to be examined (37 CFR § 1.129(b))	
1801	770	2801	385	Request for Continued Examination (RCE)	
1802	900	1802	900	Request for expedited examination of a design application	
Other fee (specify) ____					

*Reduced by Basic Filing Fee Paid SUBTOTAL (3) ($) 330

SUBMITTED BY				Complete *(if applicable)*	
Name (Print/Type)	Jordan N. Bodner	*Registration No. (Attorney/Agent)*	42,338	*Telephone*	202-824-3000
Signature				*Date*	June 29, 2004

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PTO/SB/21 (02-04)
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TRANSMITTAL FORM

(to be used for all correspondence after initial filing)

Application Number	09/605,544
Filing Date	June 29, 2000
First Named Inventor	Colin S. COLE
Art Unit	2153
Examiner Name	Anita Choudhary
Attorney Docket Number	003797.86783

ENCLOSURES ***(check all that apply)***

- ☒ Fee Transmittal Form
- ☐ Fee Attached
- ☐ Amendment / Reply
- ☐ After Final
- ☐ Affidavits/declaration(s)
- ☐ Extension of Time Request
- ☐ Express Abandonment Request
- ☐ Information Disclosure Statement
- ☐ Certified Copy of Priority Document(s)
- ☐ Response to Missing Parts/ Incomplete Application
- ☐ Response to Missing Parts under 37 CFR 1.52 or 1.53
- ☐ Drawing(s)
- ☐ Licensing-related Papers
- ☐ Petition
- ☐ Petition to Convert to a Provisional Application
- ☐ Power of Attorney, Revocation Change of Correspondence Address
- ☐ Terminal Disclaimer
- ☐ Request for Refund
- ☐ CD, Number of CD(s) ____
- ☐ After Allowance Communication to Group
- ☐ Appeal Communication to Board of Appeals and Interferences
- ☒ Appeal Communication to Group **(Appeal Notice, Brief, Reply Brief)**
- ☐ Proprietary Information
- ☐ Status Letter
- ☐ Other Enclosure(s) *(please identify below)*:

Remarks

SIGNATURE OF APPLICANT, ATTORNEY, OR AGENT

Firm or Individual name	Jordan N. Bodner, Registration No. 42,338
Signature	
Date	June 29, 2004

CERTIFICATE OF TRANSMISSION/MAILING

I hereby certify that this correspondence is being facsimile transmitted to the USPTO or deposited with the United States Postal Service with sufficient postage as first class mail in an envelope addressed to: Commissioner for Patents, P.O. Box 1450, Alexandria, VA 22313-1450 on the date shown below.

Typed or printed name			
Signature		Date	

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE
BEFORE THE BOARD OF PATENT APPEALS AND INTERFERENCES

In Re Application of:	)
	)
Colin S. Cole et al.	) Group Art Unit: 2153
	)
Serial No.: 09/605,544	) Examiner: Anita Choudhary
	)
Filed: June 29, 2000	) Attorney Docket No.: 003797.86783
	)
For: Method for Request and Response Direct Data Transfer and Management of Content Manifests	)

APPEAL BRIEF

Commissioner for Patents
P.O. Box 1450
Alexandria, VA 22313-1450

Sir:

Pursuant to 37 C.F.R. § 1.192, Appellants submit their Appeal Brief, in triplicate, to the Board of Patent Appeals and Interferences in response to the final Office Action mailed January 29, 2004 (paper no. 13). Please charge any necessary fees in connection with this Appeal Brief to our Deposit Account No. 19-0733.

REAL PARTY IN INTEREST

The owner of the above-identified application, and the real party in interest, is Microsoft Corporation.

RELATED APPEALS AND INTERFERENCES

None.

STATUS OF CLAIMS

Claims 1-10 and 12-22 are pending and are being appealed herein. The pending claims are shown in the attached Appendix. The final Office Action rejected the claims as follows:

- Claims 1, 6-10, 16, 17, 19, 20, and 22 are rejected under 35 U.S.C. § 102(e) as being unpatentable over U.S. Patent No. 6,122,372 to Hughes ("Hughes").
- Claims 12-15 are rejected under 35 U.S.C. § 102(e) as being unpatentable over U.S. Patent No. 6,446,110 to Lection et al. ("Lection").
- Claims 5, 18, and 21 are rejected under 35 U.S.C. § 103(a) as being unpatentable over Hughes in view of Lection.
- Claims 2-4 are rejected under 35 U.S.C. § 103(a) as being unpatentable over Hughes in view of U.S. Patent No. 6,507,856 to Chen et al. ("Chen").

STATUS OF AMENDMENTS

No amendments have been filed subsequent to the final Office Action.

SUMMARY OF INVENTION

In making reference herein to various portions of the specification and drawings in order to explain the claimed invention (as required by 37 C.F.R. § 1.192(c)(5)), Appellants do not intend to limit the claims; all references to the specification and drawings are illustrative unless otherwise explicitly stated.

Aspects of the present invention provide a framework that allows for the efficient exchange of data between application programs, even when the application programs are operating on different operating system platforms. Specification, p. 2, lns. 12-14. A software envelope may be generated that contains a data file, and the envelope is transmitted to a destination location. Specification, p. 2, lns. 17-18. The envelope may be implement, for example, using XML tags. Specification, p. 8, lns. 9-10; Figure 3. At the destination location, an object may be created from the data file with a plugin object. Specification, p. 2, lns. 18-20. The plugin object may be chosen to correspond to the same predetermined schema under which the data file was created. Specification, p. 2, lns. 16-20.

A particular data structure may further be used to implement such efficient data exchange. The data structure may include a first field containing address information, a second data field containing the identification of a predetermined schema, and a third data field containing a data file formatted in a markup language in accordance with the schema. Specification, p. 3, lns. 8-11. The data structure may further include a data field containing manifest information that indicates the type of information contained in the software envelope. Specification, p. 10, lns. 10-11; Figure 5.

ISSUES PRESENTED ON APPEAL

A. Whether the Examiner's reliance on a "substantial steps" test in making an anticipation rejection under 35 U.S.C. § 102 is improper.

B. Whether claims 1, 6-10, 16, 17, 19, 20, and 22 are patentable over Hughes.

C. Whether claims 12-15 are patentable over Lection.

D. Whether claims 5, 18, and 21 are patentable over Hughes in view of Lection.

E. Whether claims 2-4 are patentable over Hughes in view of Chen.

GROUPING OF CLAIMS

In accordance with 37 C.F.R. § 1.192(c)(7), Appellants respectfully request that the claims not stand or fall together. Appellants request that the following groups of separately patentable claims be recognized:

GROUP I -- Independent claims 1 and 20, and dependent claims 2-10, 21, and 22.

GROUP II -- Independent claim 16, and dependent claims 17-19.

GROUP III -- Independent claim 12, and dependent claims 13-15.

Separate arguments for patentability for Groups I-III are provided.

ARGUMENT

A. *The Examiner's Reliance on a "Substantial Steps" Test is Improper in Making an Anticipation Rejection Under 35 U.S.C. § 102*

In rejecting claims 1, 6-10, 16, 17, 19, 20, and 22 as being anticipated by Hughes under 35 U.S.C. § 102, the Examiner acknowledges that Hughes fails to teach or suggest all of the claimed features. In particular, Hughes does not teach or suggest that a plugin object creates an object from a data file as claimed. To overcome this deficiency of Hughes, the Examiner asserts that "Hughes may not use the word 'creating' a message object, however Hughes takes substantial steps for carrying out a means for creating a message object from an incoming encapsulated message." Final Office Action, p. 2. The Examiner's "substantial steps" standard has no legal basis and is wholly improper in supporting an anticipation rejection under 35 U.S.C. § 102. A claim is anticipated only if each and every element as set forth in the claim is found, either expressly or inherently described, in a single prior art reference. *Verdegaal Bros. v. Union Oil Co. of California*, 814 F.2d 628, 631, 2 USPQ2d 1051, 1053 (Fed. Cir. 1987). Importantly, the Examiner does not (and cannot) acknowledge that Hughes expressly or inherently describes each and every element as claimed.

Moreover, the Examiner's assertion that Hughes does not use the word "creating" is a red herring. While Appellants recognize that identity of terminology is not required for anticipation. *In re Bond*, 910 F.2d 831, 15 USPQ2d 1566 (Fed. Cir. 1990), Hughes's deficiency goes well beyond differing vocabulary; the claim feature, the concept itself, is simply not taught or suggested by Hughes (as will be discussed in later sections of this argument). For at least this reason, it is

respectfully submitted that the rejection of claims 1, 6-10, 16, 17, 19, 20, and 22 is improper and should be withdrawn.

B. ***Claims 1, 6-10, 16, 17, 19, 20, and 22 are Patentable Over Hughes***

Independent claim 1 is directed to a method for exchanging data between a source location and a destination location. The method of claim 1 includes the step of creating an object from a data file with a plugin object corresponding to a predetermined schema. The final Office Action alleges that this feature is found in col. 9, lns. 25-32 of Hughes, which discusses using template, protocol, and contract tags to interpret a message:

> Next, encapsulated message 200 includes a template tag 204 that provides a template CNS ID, a protocol tag 205 that provides a protocol CNS ID, and a contract tag 206 provides a contract CNS ID. The purpose of the template, protocol, and contract CNS ID's is to verifiably identify the template, protocol, and contract which should be used to interpret the encapsulated message.

Thus, this portion of Hughes discloses using template, protocol, and contract tags to *interpret* a message, not to *create* anything, much less an object, from a data file. Nor does any other portion of Hughes teach or suggest creating an object from a data file with a plugin object corresponding to a predetermined schema, as recited in claim 1.

The final Office Action acknowledges this deficiency of Hughes, and attempts to overcome it by alleging that Hughes nevertheless "takes substantial steps for carrying out a means for creating a message object from an incoming encapsulated message." Final Office Action, p. 2. As discussed

above, this "substantial steps" standard used by the Examiner is the *wrong legal standard* to apply when making an anticipation rejection under 35 U.S.C. § 102.

Moreover, neither the cited portion of Hughes, nor any other portion of Hughes, teaches or suggests the recited plugin object. The Examiner apparently attempts to compare the template tag, protocol tag, or contract tag with the claimed plugin object. However, these are merely identifying tags, not a plugin object as claimed.

For at least these reasons, Hughes by itself fails to anticipate claim 1, since Hughes does not teach or suggest creating an object from a data file with a plugin object corresponding to a predetermined schema, as required by claim 1. Moreover, the Examiner's "substantial steps" is improper and does not cure the lack of anticipation by Hughes.

Independent claim 16 is directed to a method for creating data at a source location to transmit to a destination location. The claimed method includes the steps of generating a data file with a markup language in accordance with a predetermined schema; identifying a plugin object that creates an object from the data file; generating a software envelope containing the data file; and transmitting the software envelope to the destination location.

As previously discussed, the cited portion of Hughes discloses using template, protocol, and contract tags to *interpret* a message. The cited portion of Hughes does not teach or suggest *a plugin object that creates an object* from a data file, as plainly recited in claim 16. Nor does any other portion of Hughes teach or suggest this feature of claim 16.

As also previously discussed, the "substantial steps" standard used by the Examiner is wholly improper and inappropriate to an anticipation rejection under 35 U.S.C. § 102. Notably, the Examiner has failed to show that Hughes, by itself, teaches or suggests each and every one of the features recited in claim 16.

Moreover, neither the cited portion of Hughes, nor any other portion of Hughes, teaches or suggests the recited plugin object. The Examiner apparently attempts to compare the template tag, protocol tag, or contract tag with the claimed plugin object. However, these are merely identifying tags, not a plugin object as claimed. Indeed, none of the tags in Hughes *create* anything; they merely contain identifying data. Hughes, col. 9, lns. 25-32. In contrast, claim 16 requires identifying a plugin object *that creates an object* from the data file.

For at least these reasons, claim 16 is allowable over Hughes.

Independent claim 20 is also allowable over Hughes for at least similar reasons as discussed above with regard to claim 1, and further in view of the differing features recited therein.

Claims 6-10, 17, 19, and 22 are also allowable over Hughes for at least those reasons that their respective independent claims are allowable, and further in view of the additional features recited therein.

C. ***Claims 12-15 are Patentable Over Lection***

Independent claim 12 is directed to a computer readable medium having stored thereon a data structure. The claimed data structure includes various data fields, including a data field containing a

data file formatted in a markup language in accordance with the schema, and a data field containing manifest information corresponding to information contained in the data file data field. Thus, claim 12 requires both a data file data field and a manifest information data field.

The Examiner asserts that Lection discloses both data fields as being part of a data type definition (DTD). Lection's DTD contains screen information and session information. Lection, col. 9, lns. 15-17. The screen information contains three sub-elements: content, interaction, and display sub-elements. Lection, col. 9, lns. 23-26.

The Examiner attempts to compare Lection's screen and session information with the claimed data file data field, and the sub-elements within the screen and session information with the claimed manifest information data field. However, the sub-elements of the screen and session information are *part of* the screen and session information. In other words, this portion of Lection simply discloses a screen and session information structure having content, where the content includes the sub-elements. Accordingly, Lection fails to teach or suggest *both* the claimed data field including a data file *and* the data field including manifest information corresponding to information contained in the data file, as claimed.

Even assuming for the sake of argument that the sub-elements of the screen and session information can be compared with the claimed manifest information data field, these sub-elements nevertheless do not include manifest information as claimed. Appellants' specification describes "manifest information," for example, at p. 10, ln. 10, to p. 11, ln. 10. An example of manifest

information is also shown in Fig. 5 of the specification. Manifest information may include, for example, a name of a document, a description of the document, a name of attachments, a description of the attachments, and an identification of the type of attachments. In contrast, referring to Lection's sub-elements, the content element includes information about the host screen fields including both text content and text attributes (field start position, length, protected or unprotected, and field text) Lection, col. 9, lns. 27-30. The interaction element specifies and inbound function key. Lection, col. 9, lns. 31-32. The display element stores the host-application-generated screen-display-related information, such as background and foreground color. Lection, col. 9, lns. 38-40. However, *none of these sub-elements provide manifest information* as claimed, such as the name of a document, the description of the document, the name of attachments, the description of the attachments, and the identification of the type of attachments.

For at least the above reasons, it is submitted that claim 12 is allowable over Lection.

Claims 13-15 depend from claim 12 and are also allowable for at least those reasons that claim 12 is allowable, and further in view of the additional features recited therein.

D. *Claims 5, 18, and 21 are Patentable Over Hughes in View of Lection*

Claims 5, 18, and 21 are allowable for at least those reasons that their respective independent claims are allowable, and further in view of the additional features recited therein. Moreover, the addition of Lection fails to cure the above-discussed deficiencies of Hughes. Accordingly, claims 5, 18, and 21 are also allowable over the proposed combination of Hughes and Lection.

E. ***Claims 2-4 are Patentable over Hughes in View of Chen***

Claims 2-4 depend from claim 1 and are allowable for at least those reasons that claim 1 is allowable, and further in view of the additional features recited therein. Moreover, the addition of Chen fails to cure the above-discussed deficiencies of Hughes. Accordingly, claims 2-4 are also allowable over the proposed combination of Hughes and Chen.

CONCLUSION

For all of the foregoing reasons, Appellants respectfully submit that the final rejection of claims 1-10 and 12-22 is improper and should be reversed.

Respectfully submitted,

Dated: June 29, 2004

By: 

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APPENDIX

CLAIMS INVOLVED IN THE APPEAL

1. A method for exchanging data between a source location and a destination location comprising the steps of:

generating a data file with a markup language in accordance with a predetermined schema;

generating a first software envelope containing the data file;

transmitting the software envelope to the destination location; and

creating an object from the data file with a plugin object corresponding to the predetermined schema.

2. The method of claim 1, further including the step of:

automatically generating a second software envelope from the information contained in the first software envelope.

3. The method of claim 2, wherein the first software envelope contains destination and source address information and

wherein the step of automatically generating a second envelope includes generating a second envelope having a destination address matching the source address of the first envelope.

4. The method of claim 2, wherein the first software envelope contains state information and

wherein the step of automatically generating a second envelope includes generating a second envelope having a destination address determined by the state information.

5. The method of claim 1, wherein the markup language comprises extensible markup language (XML).

6. The method of claim 1, wherein the markup language comprises standard generalized markup language (SGML).

7. The method of claim 1, wherein the step of transmitting comprises transmitting the software envelope via electronic mail.

8. The method of claim 1, wherein the step of transmitting comprises transmitting the software envelope via HTTP.

9. The method of claim 1, wherein the step of transmitting comprises transmitting the software envelope via an intermediate server.

10. A computer readable medium having computer-executable instructions for performing the steps recited in claim 1.

11. (Cancelled).

12. A computer readable medium having stored thereon a data structure comprising:

(a) a data field containing address information;

(b) a data field containing the identification of a predetermined schema;

(c) a data field containing a data file formatted in a markup language in accordance with the schema; and

(d) a data field containing manifest information corresponding to the information contained in the data file data field.

13. The computer readable medium of claim 12, further including:

(d) a data field containing state information.

14. The computer readable medium of claim 13, wherein the state information contains address information.

15. The computer readable medium of claim 12, wherein the address information contains an address for replying to a message.

16. A method for creating data at a source location to transmit to a destination location comprising the steps of:

generating a data file with a markup language in accordance with a predetermined schema;

identifying a plugin object that creates an object from the data file;

generating a software envelope containing the data file; and

transmitting the software envelope to the destination location.

17. The method of claim 16, wherein the step of generating a software envelope includes generating a software envelope containing the data file and the plugin object.

18. The method of claim 16, wherein the markup language comprises extensible markup language (XML).

19. The method of claim 16, wherein the markup language comprises standard generalized markup language (SGML).

20. A method for extracting data from a file transmitted from a source location comprising the steps of:

receiving a software envelope containing a data file marked up with a markup language in accordance with a predetermined schema; and

creating an object from the data file with a plugin object corresponding to the predetermined schema.

21. The method of claim 20, wherein the markup language comprises extensible markup language (XML).

22. The method of claim 20, wherein the markup language comprises standard generalized markup language (SGML).